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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,364	12/15/2000	Pierre Hercules Nel	3777-8	8933

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EXAMINER

CHARLES, DEBRA F

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,364

Applicant(s)

NEL, PIERRE HERCULES

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. One IDS was accompanied by the references and this was considered. The other two IDS were considered after the Examiner reviewed the documents in the parent case.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33-63 are rejected under the judicially created doctrine of double patenting over claims 1-32 of U. S. Patent No. 6507823 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the rejected claims fall within the scope of the corresponding claims in the patent.

Claim Rejections - 35 USC § 102

3. Claims 33-63 provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09739786 A which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This

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rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33,34,36,38,48,49,50,53,57,58,60 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al.(U.S. PAT. 4799156 A).

Re claims 33,49,50,53 and 63: Shavit et al. disclose a method of conducting a financial or commercial transaction between a purchaser and a vendor of a product, (Abstract) the method comprising the steps of:

utilizing a computerized banking system comprising a plurality of financial institutions(Fig. 1); each of said plurality of financial institutions comprising a computer centre comprising a plurality of computer based client accounts(col. 4, lines 27-49), an electronic data network interconnecting said financial institutions(Fig. 2, col. 15, lines 18-36); and a plurality of data exchange terminals(Fig. 2) connected to said network;

utilizing at least one vendor database including product related information connected to the said network(col. 14, line 63-col. 15, line 44);

providing product-related information to the purchaser via one of said terminals(col. 14, line 50-col. 15, line 60);

communicating to the vendor database via the network product related information regarding a product required by the purchaser and which information is provided by the purchaser via one of said terminals(col. 15, line 45-col. 16, line 29); and authorizing payment by the purchaser for the product purchased(col. 8, lines 55-67).

Re claims 34 and 48: Shavit et al. disclose a method of conducting a financial transaction between a purchaser and a vendor of a product(Abstract), the purchaser and the vendor being associated with respective first and second accounts held at respective first and second financial institutions(Fig. 2), the method comprising the steps of:

utilizing at least one vendor database including product-related information;
linking a data exchange terminal to the at least one vendor database via a data network linking said first and second financial institutions(Fig. 2, col. 14, line 63-col. 15, line 44);

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obtaining transaction-related information regarding a product required from the purchaser via the terminal(col. 16, line11-49);

communicating the transaction-related information via the network to the vendor database(col. 14, line 50-col. 15, line 17); and

initiating an electronic transfer of funds from the first account to the second account for the value of the transaction(col. 14, lines 50-63, col. 8, line 55 to col. 9).

Re claims 36 and 38: Shavit et al. disclose wherein the transferring of funds electronically involves debiting the first account and crediting the second account performed in real time(col. 14, lines 50-63, col. 8, line 55-col. 9, line 6).

Re claim 57: Shavit et al. disclose the data output of the data exchange terminal includes a screen, and the system software includes menu drivers for producing enquiry menus on the screen using which the purchaser provides transaction-related information via the data input of the data exchange terminal to the system(col. 6, lines 20-50, col.10, lines 45-67).

Re claim 58: Shavit et al. disclose the enquiry menus include icons associated with transaction options, and the purchaser is able to select a transaction option by selecting an icon using the data input(col. 6, lines 20-50, col.10, lines 45-67, col. 12, lines 40-67).

Re claim 60: Shavit et al. disclose the data exchange terminal includes a printer which issues a record of the transaction or a voucher which serves as proof of the transaction(col. 16, lines 30-49).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 35, 39, 43, 44, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al.(U.S. PAT. 4799156 A).

Re claim 35: Shavit et al. do not explicitly disclose wherein the first and second financial institutions comprise the same financial institution. However, businesses and consumers or purchasers do share the same bank in many business transactions. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ the same financial institution for transactions between two counterparties to get

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the benefit of speeding the transaction since transactions on the same institution clear on the same day.

Re claim 39: Shavit et al. do not explicitly disclose(s) the funds are transferred electronically between the first and second account at a predetermined future time. However, financial institutions routinely provide credits to the purchaser and obtain funds at a later time from customer's account whenever a previous agreement was made. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ scheduling transactions ahead of time to get the benefit of automated transactions that implement on schedule without customer action each time a transaction must be performed.

Re claim 43: Shavit et al. do not explicitly disclose(s) the transaction-related information includes at least product identification information, the value of the product and details of the account to or from which funds are to be electronically transferred.

However, most products sold as those found in a catalog include a product identification number for easy selection and identification to/by a user. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ product identification numbers to get the benefit of quickly identifying the product without a lengthy description.

Re claim 44: Shavit et al. do not explicitly disclose(s) any one or more of the steps of verifying the availability of funds in the account, the availability of the vendor product or the qualification of the purchaser to perform the transaction before conclusion of the transaction. However, performing these steps before the conclusion of the transaction would have been obvious to one with an ordinary level of skill in the art to ensure that sufficient payments are made to the appropriate vendor selling a particular product/service.

Re claims 45 and 46: Shavit et al. disclose including the step of printing a record of the transaction which serves as proof of the transaction. And the step of printing a voucher relating to the transaction which serves as proof of the transaction(col. 16, lines 30-49).

8. Claims 37,40-42, 47, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Hale et al.(U.S. PAT. 4689478).

Re claims 37 and 40-41: Shavit et al. do not explicitly disclose(s) the step of obtaining a code from the purchaser to verify authorization of the transaction and enquiry menus. However, in col. 11, lines 50-65,col. 12, lines 25-65 thereof, Hale et al. disclose(s) using a PIN for providing /verifying authorization of the transactions. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Hale et al. to obtain enhanced security and authentication functionality in the transaction process.

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Re claim 42: Shavit et al. and Hale et al. disclose claim 40 and 41. Shavit et al. further disclose the steps of displaying at least part of the product-related information of the display, and updating the product-related information in real time response or on the occurrence of a transaction between the purchaser and the vendor(col. 14, line 63-col. 15, line 60).

Re claim 47: Shavit et al. do not explicitly disclose(s) the step of reading an indicator at the terminal, the indicator being configurable by the purchaser to indicate the transaction-related information. However, in col. 13, lines 45-67 thereof, Hale et al. disclose(s) line display shows the user's current VISA balance for charges and line display shows how the user's balance will increase by the intended purchase, permitting the user to change the data. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Hale et al. to obtain the flexibility of allowing the customer to change certain indicated items.

Re claims 51 and 52: Shavit et al. do not explicitly disclose(s) the data exchange terminal is a bank service terminal. And the communication system comprises an ATM network to which the data exchange terminal, the at least one vendor database, and the first and second financial institutions are linked to facilitate the communication there between. However, in col. 1, lines 35-40 thereof, Hale et al. disclose(s) ATM network terminals. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Hale et al. to obtain the advantage of using an ATM machine for transactions.

9. Claims 54,55,56, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Bush(U.S. PAT. 5475585 A).

Re claims 54,55,61 and 62: Shavit et al. do not explicitly disclose(s) a portable storage device adapted to store product-related information and/or at least part of the system software and/or transaction records. And wherein the portable storage device comprises a smart card. However, in Fig. 7B, items 234 and 236,col. 7, lines 22-35 thereof, Bush disclose(s) smart card reader and credit card reader. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Bush so that customer's transaction data may be automatically recorded and compiled for future viewing/analyzing.

Re claim 56: Shavit et al. disclose wherein the product-related information is accessible via a data output means of the data exchange terminal and is updatable in real time or on the occurrence of a transaction between the purchaser and the vendor(Fig. 8, col. 6, lines 20-50, col. 7, lines 55-col. 8, line25).

10. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Lawlor et al.(U.S. PAT. 5220501 A).

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Shavit et al. does not explicitly disclose(s) the communication system includes conventional telephone lines or dedicated communication lines and an interface which allows the at least one vendor database to communicate with the data exchange terminal utilizing established ATM message protocols. However, Abstract and in col. 4, lines 25-36 thereof, Lawlor et al. disclose(s) ATM protocols and standards. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Lawlor et al. to obtain standardized protocols throughout the ATM network to ensure freeflow of network communication data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Debra F. Charles

Examiner

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dfc

June 29, 2003


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
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